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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,048	11/29/2001	Eric Van Hensbergen	AUS920010613US1	6041

40412 7590 08/11/2005

IBM CORPORATION- AUSTIN (JVL)
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EXAMINER

STRANGE, AARON N

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,048

Applicant(s)

HENSBERGEN, ERIC VAN

Examiner

Aaron Strange

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-11, 13-18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13-18, and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The declaration filed under 37 CFR 1.132 filed 5/8/2005 is insufficient to overcome the rejection of claims 1-4, 6-11, and 13-18 under 35 USC 102(f) as set forth in the last Office action.
2. With regard to the declaration, section 3 does not meet the requirements of a contradicted "unequivocal statement" to establish inventorship of the present application. Applicant's statements that "Mr. Papathanasiou did not conceive of the invention and did not reduce the invention, as set forth in the claims, to practice" and "In his resume Mr. Papathanasiou clearly describes his role as my research assistant and not as inventor of the subject application" are contradicted by the statements of Mr. Papathanasiou, in his resume. Mr. Papathanasiou's resume clearly states that during his time period as a "Research Intern", he performed "Design and Implementation of KNITS", which is described in the cited paper as well as the present application.

Section 3 of the declaration appears to assert that Mr. Papathanasiou merely assisted in preparation of the cited paper. However, the resume of Mr. Papathanasiou contradicts this assertion by stating that Mr. Papathanasiou designed and implemented the system. Mere acknowledgement by Mr. Papathanasiou that he was a "Research Intern" and that his "Advisor" was Mr. Hensenbergen does not preclude Mr. Papathanasiou from being an inventor of the presently claimed invention. Applicant must more clearly describe state what role, if any, Mr. Papathanasiou had in the

invention of the subject matter claimed in the present application. (See MPEP 715.01(c) and 716.10)

3. Applicant's amendments to independent claims 1,8, and 15 are sufficient to overcome the rejections under 35 USC 112, 2nd Paragraph, 35 USC 102(e), and 35 USC 103(a), presented in the Office action of 1/25/2005.

4. Applicant's amendments to the specification are sufficient to overcome the rejection under 35 USC 101, presented in the Office action of 1/25/2005.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

6. Claims 1-4, 6-11, 13-18, and 20-23 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

7. With regard to claims 1-4, 6-11, 13-18, and 20-23, the documents cited as (W) ("KNITS: Switch-based Connection Hand-off") and (X) ("Athanasios E. Papathanasiou") on the Notice of References Cited included with the Office action of 1/25/2005 provide evidence that the named inventor is not the sole inventor of the claimed subject matter.

Art Unit: 2153

In particular see document (W) in its entirety and Page 2, Lines 3-7 of document (X), coupled with the discussion of Applicant's declaration above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

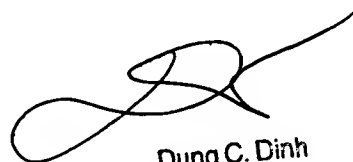
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AS
7/27/2005



Dung C. Dinh
Primary Examiner